

REMARKS

The Examiner objected to the drawings under 37 C.F.R. 1.83(a) as failing to show the adhesive layer extending into the aperture as claimed in claim 3 and 13. Applicants have submitted a proposed amended drawing Fig. 4 to overcome the rejection and request that the amended drawing be entered into the application. Support for the amendment is found at page 4, lines 11-16.

Claims 1-17 are pending in the application. The Examiner indicated on form PTOL-326 that claims 1-17 stand rejected, however, the Examiner did not address claim 10 anywhere in the Detailed Action and did not cite any art that disclosed the continuous lip as claimed in claim 10. Accordingly, applicants believe claim 10 is allowable over the cited art.

Claims 1, 2, 4, 9, 11, and 12 stand rejected under 35 U.S.C. § 102 as being anticipated by USPN 5,921,871 to Fisher. Applicants have amended claims 1 and 2 to overcome the rejection of claims 1, 2, 4, and 9 and respectfully traverse the rejection as applied to claims 11 and 12. Fisher discloses a golf club head having a front face with a recess that releasably holds a selected one of a plurality of interchangeable inserts. [Col. 3, lines 45-48] Among the stated objects of the Fisher golf club is that the insert is held in place by releasable fastening means (i.e. removable mechanical fasteners) that permit interchanging the insert with an insert having a different rebound factor and/or different hardness. [Col. 3, lines 40-43]. Fisher, therefore, does not disclose a club head having a cavity with apertures that are unobstructed by removable fasteners as claimed in claims 1, 2, 4, and 9. Moreover, since the inserts disclosed in Fisher must be releasably fastened so as to be interchangeable, Fisher does not disclose an adhesive layer disposed immediately between the lower surface of the insert and the bottom wall of the cavity as

provided in amended claim 2. Instead, the adhesive layer 47 of Fisher is immediately adjacent the lower surface of the insert 39 and the upper surface of the backing plate 50. Therefore, the adhesive layer 47 of Fisher does not adhere the insert to the cavity, it merely adheres the insert to the backing plate. For these reasons applicants believe the claims, as amended, overcome the rejections under § 102.

With regard to claims 11 and 12, as noted above, Fisher discloses a club head in which the adhesive layer is applied between the back surface of the insert and the front surface of the backing plate, not between the back surface of the insert and the bottom surface of the cavity. Accordingly, for this reason alone Fisher does not inherently anticipate claim 11, which includes the step of applying an adhesive layer between the bottom wall of the cavity and the back surface of the face insert. Moreover, Fisher discloses a cavity that is open at the top and the bottom surfaces. Since there is no closed cavity, attaching the face insert of Fisher to the club head would not force any air out of the cavity as provided in claim 12. Finally, with regard to claim 12, since the adhesive layer 47 disclosed in Fisher is between the insert 39 and the backing plate 50, and since Fisher teaches an insert that is releasably attached to the club head, Fisher in no way anticipates claim 12 in which the adhesive layer comes in contact with and bonds the back surface of the face insert to the bottom wall of the cavity. Accordingly, applicants respectfully request the rejection of claims 11 and 12 be withdrawn.

Claims 3, 5, 13, and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable considering USPN 5,921,871 to Fisher. Applicants respectfully traverse the rejection as it may be applied to the claims as amended. Claims 3 and 5 depend (directly or indirectly) from amended claim 1 and for that reason alone should be allowable. Claims 13 and 14 both depend from claim 11, and therefore, for the reasons discussed above, should be allowable.

Additionally, with respect to claims 3, 13 and 14, the adhesive layer 47 of Fisher, cited by the Examiner, is located between the insert 39 and the threaded backing plate 50. The adhesive layer 47 cannot be extruded through the apertures 53 of Fisher, because the backing plate intervenes. Moreover, if the adhesive layer were to extrude into the apertures 53 of Fisher, or were injected into the cavity through the apertures, as provided in claims 3, 13 and 14, it would render the club head of Fisher unsuitable for its intended use because it would render the insert non-interchangeable in contravention of the stated objective of the Fisher invention. It is well-settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification and a rejection based on such a proposed combination is improper. MPEP 2143.01; In Re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, for this reason alone, the rejections of claims 3, 13, and 14 should be withdrawn.

Claims 6, 7, 15, and 16 stand rejected under 35 U.S. C. § 103 considering USPN 5,921,871 to Fisher in view of USPN 5,924,939 to Grace, et al. Claims 6 and 7 depend from amended claim 1, which includes the limitation that the apertures are devoid of removable fasteners. For the reasons noted above, since a stated objective of Fisher was to provide a plurality of removable inserts, the combination suggested by the examiner, which includes apertures that are devoid of removable fasteners would render the Fisher club unsuitable for its intended purpose, since the inserts would become non-removable. Accordingly, for this reason, claims 6 and 7 should be allowable. Similarly, claims 15 and 16 depend from claim 11, which includes the limitation that an adhesive layer is applied between the bottom wall of the cavity and the back surface of the face insert. Since the adhesive layer limitation of claim 11 renders the face insert non-removable, the combination suggested by the examiner would render the club head of Fisher

unsuitable for its intended use because it would render the insert non-interchangeable in contravention of the stated objective of the Fisher invention. Accordingly, for this reason, the rejection of claims 15 and 16 should be withdrawn.

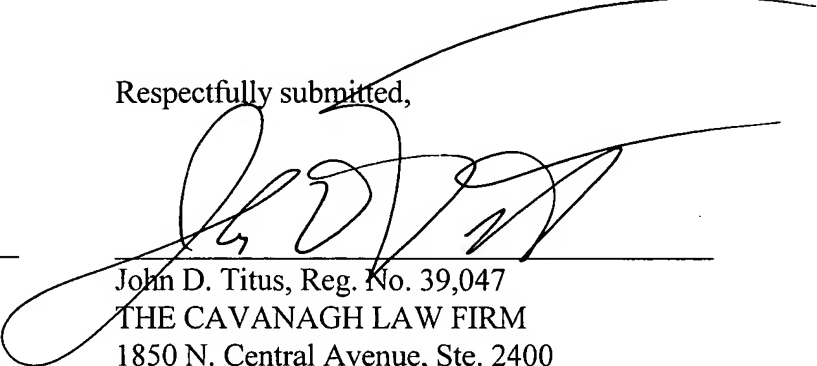
Claims 8 and 17 stand rejected under 35 U.S. C. § 103 considering USPN 5,921,871 to Fisher in view of USPN 5,924,939 to Grace, et al. further in view of USPN 6,231,458 to Camerson, et al. Claim 8 depends from amended claim 1, which includes the limitation that the apertures are devoid of removable fasteners. For the reasons noted above, since a stated objective of Fisher was to provide a plurality of removable inserts, the combination suggested by the examiner, which includes apertures that are devoid of removable fasteners would render the Fisher club unsuitable for its intended purpose, since the inserts would become non-removable. Accordingly, for this reason, claim 8 should be allowable. Similarly, claim 17 depends from claim 11, which includes the limitation that an adhesive layer is applied between the bottom wall of the cavity and the back surface of the face insert. Since the adhesive layer limitation of claim 11 renders the face insert non-removable, the combination suggested by the examiner would render the club head of Fisher unsuitable for its intended use because it would render the insert non-interchangeable in contravention of the stated objective of the Fisher invention. Accordingly, for this reason, the rejection of claim 17 should be withdrawn.

Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

Respectfully submitted,

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